

REMARKS

By this amendment, claims 1-40 are pending, in which no claim is canceled, currently amended, or newly added.

The final Office Action mailed February 1, 2006 rejected claims 1, 5-9, 13-17, 21-25, 29-33 and 37-40 as obvious under 35 U.S.C. § 103 based on *Cox et al.* (US 2002/0115431) in view of *Gerszberg et al.* (US 6,052,439), and claims 2-4, 10-12, 14, 18-20, 26-27, and 34-36 as obvious under 35 U.S.C. § 103 based on *Cox et al.* in view of *Gerszberg et al.* and in further view of *Shah et al.* (US 6,212,506).

Independent claim 1 recites “in response to a selection of more than one of the directory listings from the client access device, **transmitting a plurality of listing numbers to the client access device**; and **preparing billing information based upon a number of the plurality of listing numbers transmitted to the client access device.**” Claim 9 recites as “in response to a selection of more than one of the directory listings from the client access device, **transmitting a plurality of listing numbers to the client access device**” and “a processor configured to **prepare billing information based upon a number of the plurality of listing numbers transmitted to the client access device.**” Claim 17 recites “**means for transmitting a plurality of listing numbers to the client access device** in response to a selection of more than one of the directory listings from the client access device; and **means for preparing billing information based upon a number of the plurality of listing numbers transmitted to the client access device.**” Also, claim 25 recites “in response to a selection of more than one of the directory listings from the client access device, **transmitting a plurality of listing numbers to the client access device**” and “a server configured to **prepare billing information based upon a number of the plurality of listing numbers transmitted to the client access device.**” Claim 33 recites “**transmitting a plurality of listing numbers to the client access device** in response to a

selection of more than one of the directory listings from the client access device; and **preparing billing information based upon a number of the plurality of listing numbers transmitted to the client access device.**"

Essentially, the current Office Action does not present any new rebuttal to Applicants' arguments proffered in the Response dated October 31, 2005. Applicants maintain that the claimed billing feature is not disclosed by *Cox et al.* or *Gerszberg et al.*, alone or in combination. For such a supposed teaching, the Office Action relies on the passage of paragraphs 45-47 of the *Cox et al.* These paragraphs state the following (Emphasis Added):

[0045] 1) **The directory assistance service provides "tickets" of all calls that were transferred and answered. The precise content and format of the ticket is customer-defined, but includes at least the following information: calling number, called number, date and time of connection (i.e. when answer indication was received), and duration of call.** The ticket files can be transferred on magnetic tape or by means of electronic file transfer.

[0046] 2) The digits that are dialed by the directory assistance service's PBX to initiate the call transfer (via the cellular carrier's network) can incorporate the calling party number ("A" Number Identification, or ANI). The cellular carrier's own switching equipment then has all the information needed to generate the required tickets.

[0047] **It is the cellular carrier's responsibility to rate the calls and determine what charge is to be levied.** Having described the principles of our invention with reference to a preferred embodiment and certain variations thereon, it should be apparent that these examples can be modified in arrangement and detail without departing from such principles. For example, while the invention has been illustrated with reference to a system in which a "starback" customer is routed back to the next available operator, in other embodiments, provision can be made for routing the customer back to the original operator. (In some systems, the customer can be given a choice: pressing one key for the first available operator, and another key to be inserted in the original operator's queue.)

From the above passage, it is clear that the *Cox et al.* system decouples the billing process from the directory assistance service, in that responsibility for the billing is placed on the cellular carrier, not on the directory assistance service. Therefore, for billing to occur, a call must be

established using the listed number. Therefore, it is not possible that simply listing the numbers would trigger preparation of a bill.

Understandably, the Office Action acknowledges (on page 6) that the *Cox et al.* “teaches charging for selection listings but not a plurality.” However, the Office Action conveniently ignores the technical inadequacies of *Cox et al.* to conclude that because *Gerszberg et al.* teaches multiple listings, presumably the billing system of *Cox et al.* can be modified to bill for multiple listings. Perhaps in recognition of the tenuousness of this line of reasoning, the Office Action summarily declares that “[i]t is old and well known in the retail industry that you pay for items you get, therefore, if you are getting multiple listings you will pay for multiple listings.” Such approach has no grounding in fact or law.

First, Applicants respectfully submit that an objective of the billing mechanisms of *Cox et al.* is to make it the cellular carrier’s responsibility to determine what charge is to be levied, not the provider of the directory assistance service (paragraph 47). It is noted that a conclusion of obviousness is not compelled by the fact that the prior art could be modified so as to result in the combination defined by the claims; obviousness turns on whether the prior art suggests the desirability of the modification. The requisite motivation to establish a *prima facie* case of obviousness cannot be established by undercutting the expressed objectives of an applied reference. See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968). The modification that is proposed by the Office Action is to make the directory assistance service provider assume the responsibilities of what to charge (which is contrary to the objective of *Cox et al.*).

Second, to the extent the Examiner is relying on common knowledge that “you pay for items you get”; this is insufficient to support a *prima facie* case of obviousness under the

Administrative Procedure Act (APA). That is, the Office Action's assertion that "you pay for items you get" is insufficient as a matter of law, because such conclusory statements, premised on "common knowledge and common sense," fail to fulfill requirements of the Administrative Procedure Act, *In Re Sang Su Lee*, No. 00-1158 (Fed. Cir. Jan. 18, 2002), and that deficiencies of the cited references cannot be remedied by general conclusions about what is "basic knowledge" or "common sense." *In Re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697.

Third, to the extent the Examiner is taking Official Notice of the claimed billing feature, pursuant to the MPEP § 2144.03, Applicants respectfully traverse the Official Notice and request the Examiner to produce references showing the claim features or withdraw the rejection as factually inadequate. Further, although the Examiner may in some instances take official notice of certain facts to fill in the gaps, such facts should not comprise the principle evidence upon which a rejection is based. See *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970).

In view of the foregoing, Applicants respectfully request withdrawal of the obviousness rejection, and urge the indication that claims 1, 5-9, 13-17, 21-25, 29-33 and 37-40 are allowed.

With regard to the rejection of dependent claims 2-4, 10-12, 18-20, 26-27, and 34-36, Applicants respectfully submit that the addition of *Shah et al.* does not cure the deficiencies of *Cox et al.* and *Gerszberg et al.* Moreover, these dependent claims are allowable on their own merits. For example, dependent claim 2 recites "wherein the information in the transmitting step includes **partial directory information**." Presumably, the Office Action relies on the additional reference of *Shah et al.* for this feature. The Office Action, on page 5, cites the following passages: col. 4: 23-25 and 31-33. The passage of col. 4: 23-33 (encompassing the cited passages) state the following (Emphasis Added):

Customer database (CDB) 112 is a **database containing information for customers which is utilized to determine rates for calls from a source location to various target locations, including customer rate profile, geographic information used for charge calculations, call attribute rate information, etc.** Customer database 112 serves as a repository for billing rate information and may be maintained within a switch as illustrated in FIG. 2, or external to a switch, as depicted in FIGS. 1 and 3A-3B. Routing information database (RIDB) 212 within communications system 200 contains routing information utilized for call processing.

This passage makes no mention of **“partial directory information.”** The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

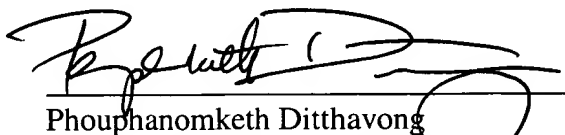
Accordingly, the obviousness rejection of claims 2-4, 10-12, 18-20, 26-27, and 34-36 is unsustainable.

Therefore, the present application overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date


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